

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Reissue Application of:
RICHARD P. METTKE

November 3, 1998

Serial No.: 09/134,831

Filed: August 17, 1998

Title: ON-LINE COMMUNICATION
TERMINAL/APPARATUS

ATTENTION:
Gerald Goldberg
Art Unit: 2700

Hon. Commissioner of Patents
and Trademarks
United States Patent and Trademark Office
Washington, D.C. 20231

Sir:

AFFIDAVIT OF DANIEL J. TOUGHEY

1 I, Daniel J. Toughey, President of TouchNet Information Systems, Inc., the Protestor in the
2 above-identified Application for Reissue, having personal knowledge of all the exhibits now being
3 filed in this Protest with the U.S. Patent and Trademark Office in protest to Application for Reissue
4 Serial No. 09/134,831 declare as follows:



1. In all documents provided in this Protest the name TOUCHFAX and TOUCHFAX INFORMATION SYSTEMS, INC., refers to the entity now known and operating as TOUCHNET INFORMATION SYSTEMS, INC. This difference is the result of a company change of name in approximately late 1993.

2. Exhibit A is a true and correct copy of U. S. Application Serial No. 07/600,712 entitled "Multi-Purpose Public Facsimile Transmission Terminal," filed October 19, 1990, by inventor John C. Massey;

3. Exhibit B is a true and correct copy of Australian Patent Document No. AU-B-85947/91; entitled "Multi-Purpose Public Facsimile Transmission Terminal"; Application No. 859471/91, Application Date October 18, 1991, Published date of Accepted Application August 8, 1993;

4. Exhibit C is a sales and advertising video tape titled TOUCHFAX AMERICA and produced in May of 1993 as stated in the opening frame of the video tape. Several hundred copies of this video tape were distributed to the public at the Spring 1993 COMDEX computer trade show held in Atlanta, Georgia in June of 1993. This video tape shows that TOUCHNET (then called TOUCHFAX) had invented and advertised a device which was capable of pay-per-use connection to both on-line service providers such as PRODIGY® and to the Internet and both of these capabilities are advertised on the video tape.

1 5. Exhibits C,1 to C,6 are photo prints of particular frames taken from the Exhibit C
2 video tape. These photo prints are true copies of the subject matter shown on the
3 video tape of Exhibit C.

4 6. Exhibit D titled "TOUCHFAX NETWORK TOPOGRAPHY DIAGRAM" is sales
5 literature of TouchFax Information Systems, Inc. dated 1991 as identified by the
6 copyright notice provided thereon. This document was first publicly distributed in
7 1991.

8 7. Exhibit E is an article reprint titled "TouchFax Provides the Ultimate in Place-Based
9 Interactivity." This article was first published in *Interactive World* magazine and
10 publicly distributed in the October 1992 issue as identified thereon.

11 8. Exhibit F is a TouchFax product advertising flyer entitled,
12 "VISION...POWER...VERSATILITY." This advertising flyer was first publicly
13 distributed in 1991 as evidenced by the copyright notice of 1991 printed thereon.

14 9. Exhibit G is a TouchFax product advertising flyer entitled, "HIGH-TECH, HIGH-
15 TOUCH, TOUCHFAX." This TouchFax advertising flyer was first publicly
16 distributed in 1992 as evidenced by the copyright notice of 1991 printed thereon.

17 10. Exhibit H is a copy of U.S. Patent No. 4,359,631 issued to Lockwood, *et al.* entitled,
18 "Self-Service Terminal," filed July 11, 1980 and issued November 16, 1982.

1 11. Exhibit I is a copy of two Office Actions received by the inventor during the
2 prosecution of the Patent Application of Massey in Exhibit A.

3 12. Exhibit J is a copy of a sales letter to Ms Linda Lee Coyner of Bell South from John
4 F. Murphy of TouchFax and dated July 13, 1992 and offering for sale TouchFax
5 terminals which connect to the PRODIGY® on-line information service.

6 13. Exhibit K is a true copy of my sworn deposition dated June 16, 1998 and taken in
7 Richard P. Mettke vs. TouchNet Information Systems, Inc. before the U.S. District
8 Court for the Northern District of Alabama - Eastern Division in Case No. CV 98-PT-
9 596-E.


10 14. Exhibit L is a true copy of the sworn deposition of John F. Murphy, Vice-President
11 of Market Development for TouchNet Information Systems, Inc., dated June 16,
12 1998 and taken in Richard P. Mettke vs. TouchNet Information Systems, Inc. before
13 the U.S. District Court for the Northern District of Alabama - Eastern Division in
14 Case No. CV 98-PT-596-E.

15. Exhibit M is a true copy of the ORDER of U.S. District Court for the Northern District of Alabama - Eastern Division dismissing, with prejudice Plaintiff, Richard P. Mettke's claim of patent infringement against TouchNet Information Services, Inc. and ORDERING that plaintiff never again "assert United States patent No. 5,602,905 against defendant TouchNet Information Systems, Inc., its customers, licensees or assigns.

DECLARATION OF DANIEL J. TOUGHEY

I, Daniel J. Toughhey, hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this verified statement is directed.

Dated: 11/3/98


Daniel J. Toughey
President,
TouchNet Information Systems, Inc.